REMARKS:

This paper is herewith filed in response to the Examiner's final Office Action mailed on February 3, 2009 for the above-captioned U.S. Patent Application. This office action is a final rejection of claims 1-30 and 34-35 of the application.

More specifically, the Examiner has rejected claims 21-22 under 35 USC 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention; rejected claim 35 under 35 USC 101 alleging the claimed invention is directed to non-statutory subject matter; rejected claims 1-24, 26-30, and 34-35 under 35 USC 102(e) as anticipated by Ma (20050021940); and rejected claim 25 under 35 USC 103(a) as being unpatentable over Ma in view of Ben-David (US20040043790). The Applicants respectfully disagree with the rejections.

Claims 1, 3, 5, 7, 11-12, 14-16, 18, 21-22, 24, 29, and 34-35 have been amended for clarification. Claims 36-37 have been added. Support for the amendments and new claims can be found at least in paragraphs [0031] and [0042]. No new matter is added.

Regarding the rejections of claims 21 and 22 under 35 USC 112, second paragraph, the claims have been amended to depend from claim 18. The Applicants submit that the rejections are seen to be overcome and the rejections should be removed.

Regarding the rejections of claims 35 under 35 USC 101 the Applicants submit that claim 35 as amended is seen to clarify, for the Examiner, that the processor is executing the program instructions. The rejection of claim 35 is seen as overcome and the rejection should be removed.

Regarding the rejections of claims 1-24, 26-30, and 34-35 under 35 USC 102(e) as being anticipated by Ma, the Applicants disagree with the rejections.

First, the Applicants respectfully disagree with the Examiner's apparent assertion that the

affidavit submitted in the previous Response to the Office Action is insufficient to overcome the reference Ma (20050021940). The Applicants submit that although Ma is not agreed to be valid prior art against the Application, to further prosecution of the Application, the Applicants herein argue against the rejections, based in part on Ma, in the present Office Action.

Regarding the rejection of claim 1 the Applicants respectfully disagree with the rejection.

Ma discloses a method wherein a first wireless device may request one or more authentication keys or algorithms in order to respond to a request made by a carrier. According to Ma the first wireless communication device 104 receives a random number from the carrier cell site and the first wireless communication device 104 relays that number to the second wireless communication device 108. The second wireless communication device, of Ma, then processes the random number using a subscriber identity module implemented within the second wireless device. Then, after processing is done, the processed algorithmic output of the subscriber identity module is transported back to the cell site 120, apparently via the first communication device, where it is evaluated. Ma indicates that if the algorithmic output matches what is calculated at the carrier's site, then there is a successful authentication, (par. [0029]).

The Applicants note that it can be seen that the Examiner appears to equate the second wireless communication device in Ma to a second apparatus **which controls access to a radio communications network** as in claim 1. However, the Applicants submit that, according to Ma, it is the cell site 120 which makes the determination whether there is a successful authentication (par. [0029]). The Applicants submit that **the control of access to the carrier network, in Ma, is clearly decided by the cell site 120 and is not decided by the second wireless communication device 108**. Thus, the rejection is seen to be improper for at least the reason that the second wireless communication device of Ma, as applied in the rejection, can not be seen to relate to an apparatus **which controls access to a radio communications network** as in claim 1.

Further, as stated above, a random number is provided to the first wireless communication device by the cell site 120, and this number is relayed to the second wireless communication device via

the first wireless communication device. Therefore, although the second wireless communication device 108 may process the random number provided, the second wireless communication device 108 clearly can not be seen to be generating the random number.

The Applicants note that although the algorithmic output of the subscriber identity module in Ma is a result of the random number provided to it, there can not be seen where the second wireless communication device is **both generating a secret and using the generated secret to create a secret key**. The Applicants submit that the rejection fails to show the elements of claim 1 which relate to storing in a second apparatus **a secret generated at the second apparatus** and **creating in the second apparatus, using the secret, a secret key** for use in pairing the first and second apparatus to secure communication between the first and the second apparatus.

It is noted that, as cited, Ma discloses that "**the wireless communication devices are securely paired or coupled in order to facilitate a transfer of authentication data** processed by one or more keys and/or algorithms implemented in the second wireless communication device. [and] The **pairing process identifies and utilizes a specific set of one or more keys and algorithms** incorporated in the subscriber identification mechanism employed in the authentication process, (emphasis added), (par. [0032]). The Applicants further note that the Examiner appears to rely on this statement by Ma, where in the rejection it is stated "[there is] secure pairing and wireless communication via one more keys and/or algorithms] (0032)." However, the Applicants submit that this statement is seen to be unclear for at least the reason that no further details can be found with regards to a pairing process identifying and utilizing one or more keys and algorithms incorporated in the subscriber identification mechanism. Moreover, the Applicants can not find in Ma where it is disclosed or suggested that **a stored key is made available, by the second wireless communication device, to the first wireless communication device**, and **where the stored key is used to generate a secret key for pairing** the first and second wireless communication device, as is more particularly stated in the amended independent claim 1.

Rather, as described in relation to Fig. 2 step 208 of Ma the first wireless communication device may **initiate pairing when it receives a sequence such as a user input PIN at the first**

wireless communication device (par. [0037]). Similarly as described in relation to Fig 4 step 408 a user initiates pairing by **correctly inputting a PIN to a touch pad of a phone or PDA** (par. [0039]). Thus, it appears that pairing in Ma is initiated in response to a user of a first wireless communication device inputting a PIN at the device. The Applicants can not find in all of Ma where it is disclosed that **the PIN is made available, by the second wireless communication device, to the first wireless communication device**. For at least the reasons stated above, the Applicants submit that Ma can not be seen to relate to the second wireless communication device **generating a secret, making the secret available to the first wireless apparatus**, and **using the generated secret to create a secret key for use in pairing** the first and second wireless communication device, as appears argued in the rejection

The Applicants note that a 35 USC 102 rejection requires that the cited art disclose to the specificity of the rejected claim; Verve, LLC v. Crane Cams, Inc., 311 F.3d 1116, 1120, 65 USPQ2d 1051 (Fed. Cir. 2002) ("A single reference must describe the claimed invention with sufficient precision and detail to establish that the subject matter existed in the prior art"). It is axiomatic that a 35 USC 102(b) rejection requires strict identity with every claim element.

Further, the Examiner is respectfully reminded that for a rejection to be made on the basis of anticipation, it is well recognized that "to constitute an anticipation, all material elements recited in a claim must be found in one unit of prior art", Ex Parte Gould, BPAI, 6 USPQ 2d, 1680, 1682 (1987), citing with approval. In re Marshall, 578 F.2d 301, 304, 198 USPQ 344, 346 (CCPA 1978).

The Applicants note that, in order to further prosecution of the claims to allowance, claim 1 has been amended to recite:

> A method, comprising: storing in a second apparatus which controls access to a radio communications network a secret generated at the second apparatus, wherein the stored secret is associated with an operational mode of the second apparatus; making the stored secret available at a first apparatus without contemporaneous user input; and creating in the second apparatus, using the

secret, a secret key for use in pairing the first and second apparatus to secure communication between them.

It can be seen that features of claim 3 has been incorporated into claim 1. Further, claim 3 has been amended to relate to wherein the operational mode comprises a game mode.

The Applicants note that an exemplary embodiment of the invention relates to a method performed in a device which controls access to a radio communications network. In accordance, the device generates and stores one or more shared secrets or PINs. The stored secret is associated with an operational mode of the device. When a new device attempts to join the network, the signaling received from the new device is evaluated at least to determine whether the signaling is associated with an operational mode of the device. This operational mode can include a game mode. If it is determined that the signaling is associated with such an operational mode, then the device automatically creates on the device, without user intervention, a secret key for use in pairing the device and the new device to secure communication between them. A motivation, as described in the detailed description, is that the user of the device is therefore not disturbed or interrupted when the signaling is associated with a service or operational mode of the device, (paragraphs [0026], [0029] – [0031], [0036], and [0042]).

The Applicants can not find in all of Ma where there is disclosed or suggested that a stored secret is associated with an operational mode of the second apparatus, as in amended claim 1.

The Applicants submit that, for at least the reasons already stated above, Ma can not be seen to disclose or suggest claim 1 and the rejection of claim 1 should be removed.

Further, for at least the reasons that independent claims 12, 14, and 34-35 recite features similar to claim 1, as stated above, Ma can not be seen to disclose or suggest these claims.

In addition, although the Applicants do not agree that a combination of Ma and Ben-David is even proper, the Applicants submit that Ben-David can not be seen to overcome the shortfalls of

Ma, as stated above. Thus, the rejection of claim 35 under 35 USC 103(a) is seen to be improper and the rejection should be removed.

Further, Ma is not seen to disclose or suggest claims 2, and 4-11, claim 13, claims 15-30, and claims 36-37, for at least the reason that they depend from claims 1, 12, 14, and 35, respectively.

Based on the above explanations and arguments, it is clear that the references cited cannot be seen to disclose or suggest claims 1-30 and 34-37. The Examiner is respectfully requested to reconsider and remove the rejections of claims 1-30 and 34-35 and to allow all of the pending claims 1-30 and 34-37 as now presented for examination.

For all of the foregoing reasons, it is respectfully submitted that all of the claims now present in the application are clearly novel and patentable over the prior art of record. Should any unresolved issue remain, the Examiner is invited to call Applicants' attorney at the telephone number indicated below.

Respectfully submitted:

3/27/09

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I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner for Patents, P.O. BOX 1450, Alexandria, VA 22313-1450.

3/27/2009
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